

PTO/SB/17 (12-04v2)

Approved for use through 7/31/2006. OMB 0651-0032
U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

Under the Paperwork Reduction Act of 1995, no person are required to respond to a collection of information unless it displays a valid OMB control number.

Effective on 12/08/2004.
Fees pursuant to the Consolidated Appropriations Act, 2005 (H.R. 4818).

FEE TRANSMITTAL For FY 2005

Applicant claims small entity status. See 37 CFR 1.27

TOTAL AMOUNT OF PAYMENT (\$ 2,290.00)

Complete if Known

Application Number	09/847,999
Filing Date	May 4, 2001
First Named Inventor	Gerald W. Ingram
Examiner Name	Khanh B. Pham
Art Unit	2177
Attorney Docket No.	43799-204796

METHOD OF PAYMENT (check all that apply)

Check Credit Card Money Order None Other (please identify): *SEP 28 2005*

Deposit Account Deposit Account Number: 22-0261 Deposit Account Name: *Venable LLP*

For the above-identified deposit account, the Director is hereby authorized to: (check all that apply)

Charge fee(s) indicated below Charge fee(s) indicated below, except for the filing fee

Charge any additional fee(s) or underpayment of fee(s) under 37 CFR 1.16 and 1.17 Credit any overpayments

FEE CALCULATION

1. BASIC FILING, SEARCH, AND EXAMINATION FEES

<u>Application Type</u>	<u>FILING FEES</u>		<u>SEARCH FEES</u>		<u>EXAMINATION FEES</u>		<u>Fees Paid (\$)</u>
	<u>Fee (\$)</u>	<u>Small Entity</u>	<u>Fee (\$)</u>	<u>Small Entity</u>	<u>Fee (\$)</u>	<u>Small Entity</u>	
Utility	300	150	500	250	200	100	
Design	200	100	100	50	130	65	
Plant	200	100	300	150	160	80	
Reissue	300	150	500	250	600	300	
Provisional	200	100	0	0	0	0	

2. EXCESS CLAIM FEES

Fee Description

Each claim over 20 (including Reissues)

Small Entity
Fee (\$) Fee (\$)

50 25

Each independent claim over 3 (including Reissues)

200 100

Multiple dependent claims

360 180

<u>Total Claims</u>	<u>Extra Claims</u>	<u>Fee (\$)</u>	<u>Fee Paid (\$)</u>	<u>Multiple Dependent Claims</u>
- 20 =	x	=		<u>Fee (\$)</u> <u>Fee Paid (\$)</u>

<u>Indep. Claims</u>	<u>Extra Claims</u>	<u>Fee (\$)</u>	<u>Fee Paid (\$)</u>	
- 3 =	x	=		

3. APPLICATION SIZE FEE

If the specification and drawings exceed 100 sheets of paper (excluding electronically filed sequence or computer listings under 37 CFR 1.52(e)), the application size fee due is \$250 (\$125 for small entity) for each additional 50 sheets or fraction thereof. See 35 U.S.C. 41(a)(1)(G) and 37 CFR 1.16(s).

<u>Total Sheets</u>	<u>Extra Sheets</u>	<u>Number of each additional 50 or fraction thereof</u>	<u>Fee (\$)</u>	<u>Fee Paid (\$)</u>
- 100 =	/50	(round up to a whole number) x	=	

4. OTHER FEE(S)

Non-English Specification, \$130 fee (no small entity discount)

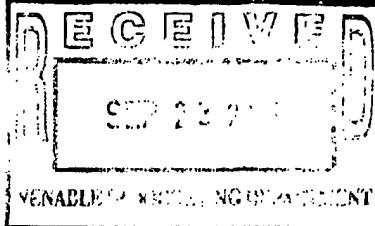
Other (e.g., late filing surcharge): 1801 Request for continued examination (RCE) (see 37 ...	790.00
1453 Petition to revive unintentionally abandoned ...	1,500.00

SUBMITTED BY				
Signature		Registration No. (Attorney/Agent)	47,294	Telephone (202) 344-4000
Name (Print/Type)	Edward W. Yee	Date	September 26, 2005	



UNITED STATES PATENT AND TRADEMARK OFFICE

RA: MAS
WA: EWY



VENABLE LLP
P.O. BOX 34385
WASHINGTON DC 20045-9998

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

COPY MAILED

SEP 22 2005

OFFICE OF PETITIONS

In re Application of :
Gerald W. INGRAM et al. :
Application No. 09/847,999 :
Filed: May 4, 2001 :
Attorney Docket No. 43799-204796 :

ON PETITION

This is a decision on the petition under 37 CFR 1.183, filed July 25, 2005, seeking waiver of the rules.

The petition is **DISMISSED**.

Petitioner requests waiver of the rules as all rejections of the pending claims have been reversed by the Board of Patent Appeals and Interferences (BPAI) or timely rendered moot in view of the amendments to the claims in copending Application No. 09/594,786.

37 CFR 1.197 states:

- (a) After decision by the Board of Patent Appeals and Interferences, the application will be returned to the examiner, subject to appellant's right of appeal or other review, for such further action by appellant or by the examiner, as the condition of the application may require, to carry into effect the decision.
- (b) Appellant may file a single request for rehearing within two months from the date of the original decision, unless the original decision is so modified by the decision on rehearing as to become, in effect, a new decision, and the Board of Patent Appeals and Interferences so states. The request for rehearing must state with particularity the points believed to have been misapprehended or overlooked in rendering the decision and also state all other grounds upon which rehearing is sought. See § 1.136(b) for extensions of time for seeking rehearing in a patent application and § 1.550(c) for extensions of time for seeking rehearing in a reexamination proceeding.
- (c) Termination of proceedings.

Application No. 09/847,999

- (1) Proceedings are considered terminated by the dismissal of an appeal or the failure to timely file an appeal to the court or a civil action (§ 1.304) except:
 - (i) Where claims stand allowed in an application; or
 - (ii) Where the nature of the decision requires further action by the examiner.
- (2) The date of termination of proceedings is the date on which the appeal is dismissed or the date on which the time for appeal to the Court or review by civil action (§ 1.304) expires. If an appeal to the Court or a civil action has been filed, proceedings are considered terminated when the appeal or civil action is terminated. An appeal to the U.S. Court of Appeals for the Federal Circuit is terminated when the mandate is issued by the Court. A civil action is terminated when the time to appeal the judgment expires.

37 CFR 1.198 states:

Cases which have been decided by the Board of Patent Appeals and Interferences will not be reopened or reconsidered by the primary examiner except under the provisions of § 1.114 or § 1.196 without the written authority of the Director, and then only for the consideration of matters not already adjudicated, sufficient cause being shown.

37 CFR 1.181(f) states:

- (f) The mere filing of a petition will not stay any period for reply that may be running against the application, nor act as a stay of other proceedings. Any petition under this part not filed within two months of the mailing date of the action or notice from which relief is requested may be dismissed as untimely, except as otherwise provided. This two-month period is not extendable.

The issue at hand is not what actions petitioner has taken in another patent application; rather it is whether petitioner has properly responded to the decision by the BPAI mailed May 26, 2005. The BPAI decision affirmed the examiner's provisional rejection of claims 31-33 under 35 U.S.C. 101. Under the rules of practice before the USPTO petitioner may have: (1) requested rehearing under 37 CFR 41.52; (2) timely filed an appeal to the Court or review by civil action under 37 CFR 1.304; or (3) filed an RCE under 37 CFR 1.114. Petitioner has done neither.

Petitioner failed to request rehearing under 37 CFR 41.52 while the case was still before the BPAI, and therein seek directly from the BPAI guidance or amplification regarding the above decision, as did the appellants in Ex parte Gartin, 90 USPQ 392, 395 (Bd. Pat. App. 1950) and in Ex parte Druey, 145 USPQ 219, 221 (Bd. Pat. App. 1964).

Application No. 09/847,999

Petitioner further failed to file an RCE under 1.114 per 37 CFR 1.198 seeking to reopen prosecution before the examiner. Rather petitioner merely filed a petition under 37 CFR 1.183, which did not of itself toll the period for seeking judicial review under 37 CFR 1.04. See 1.181(f). Furthermore, any attempt at reopening of prosecution must comply with 37 CFR 1.198. See e.g., Ex parte Bourne, 1904 Dec. Comm'r Pat. (1904) (reopening refused where applicant suggests that proposed claims are patentable but where no tribunal of the USPTO has ever suggested that the proposed claims would be allowable). See, Nitto Chem. Indus. Co. v. Comer, 39 USPQ2d 1778, 1782 (D.D.C. 1994) (circumstances are not extraordinary, and do not require waiver of the rules, when a party makes an avoidable mistake in filing-- or not filing-- papers).

Circumstances resulting from petitioners', or petitioners' counsel's, failure to exercise due care, or lack of knowledge of, or failure to properly apply, the patent statutes or rules of practice are not, in any event, extraordinary circumstances where the interests of justice require the granting of relief. See, In re Tetrafluor, Inc., 17 USPQ2d 1160, 1162 (Comm'r Pats. 1990); In re Bird & Son, Inc. 195 USPQ 586, 588 (Comm'r Pats. 1977).

However failure to know and properly apply the rules of practice before the USPTO is not a basis for seeking waiver of the rules under 1.183. Furthermore, extraordinary relief will not be considered where the rules of practice already provide an avenue for relief. It is brought to petitioner's attention that the USPTO will not normally consider an extraordinary remedy, when the rules already provide an avenue for obtaining the relief sought. See Cantello v. Rasmussen, 220 USPQ 664, 664 (Comm'r Pat. 1982). Here, as noted above petitioner could have sought to reopen prosecution before the examiner by way of e.g. 37 CFR 1.114. Further in this regard, a standard principle of statutory construction is: *expressio unius est exclusion alterius* (the mention of one thing implies exclusion of another thing), namely absent legislative intent to the contrary, when a statute expressly provides a specific remedy for a specific situation, the statute is deemed to exclude other remedies for such situation. See National R.R. Passenger Corp. v. National Ass'n Of R.R. Passengers, 414 U.S. 453, 458 (1974); see also Botany Worsted Mills v. United States, 278 U.S. 282, 289 (1929) ("when a statute limits a thing to be done in a particular mode, it includes the negative of any other mode"). That is, the patent statute at 35 U.S.C. § 132(b) (and its promulgating regulation 37 CFR 1.114) provides a specific mechanism whereby an applicant may petition the USPTO to reopen prosecution. Since there is a specific mechanism in place to remedy the requested relief then it is inappropriate for the USPTO to contemplate circumventing that mechanism by creating another remedy. Likewise as the statute provides at §41(a)(7) a mechanism for revival of an inadvertently abandoned application, it would be an improper exercise of 37 CFR 183 and seek to forestall, or overcome abandonment as the petition requests.

Telephone inquiries concerning this decision should be directed to David A. Bucci at (571) 272-7099 or in his absence, the undersigned at (571) 272-3217.

Application No. 09/847,999

The application file is being referred to Technology Center AU 2177 for consideration of processing this case as an **abandonment** in view of petitioners failure to file an appropriate response to the decision mailed May 26, 2005.

A handwritten signature in black ink, appearing to read "Brian Hearn".

Brian Hearn
Petitions Examiner
Office of Petitions